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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,865	10/16/2003	Walter Schubert	S159 1030.1	7435

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11/22/2006

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EXAMINER

MOSS, KERI A

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,865

Applicant(s)

SCHUBERT, WALTER

Examiner

Keri A. Moss

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment filed September 6, 2006 is hereby acknowledged.

Claims 1-10 are pending.

Response to Amendment

1. Rejection of claims 1-10 under 35 U.S.C. 112, 2nd paragraph is withdrawn in light of applicant's amendments.

Rejections under Stillman, Furuoya and McCaffery are maintained as applicant has not overcome the rejection by meeting the requirements for perfecting foreign priority under MPEP § 706.02(b).

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

3. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of EP 02001519.4 has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1743

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims **1, 3, 5-7, 9-10** are rejected under 35 U.S.C. 102(e) as being anticipated by Stillman (US Pub No 2003/0175827). Stillman discloses a method for preparing biological samples for analysis comprising placing the biological sample on a two-dimensional support (paragraph 10), applying protein-precipitating or denaturing solution (paragraphs 17-18), leaving the protein-precipitating or denaturing solution (paragraph 10) and drying the sample in air (paragraph 10). The biological samples are mixtures of proteins. The protein-precipitating or denaturing solution is an organic solvent (paragraphs 17-18) with critical pH values (paragraph 10) and optionally a salt solution (paragraph 17). The organic solvent is methanol or ethanol (paragraph 18). The temperature at which the reaction takes place appears to be approximately room temperature, 22 degrees Celsius, which anticipates applicant's claimed range (paragraph 21). Following drying, the biological samples are subjected to protein determination (paragraph 19).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1743

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stillman. Stillman does not disclose a method in which the sample is dried prior to adding the denaturing solution. However, changing the order of method steps is an obvious modification. In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946). Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of Stillman by changing the order in which the drying step takes place.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stillman in view of Furuoya (USP 5,079,157). Stillman does not disclose freezing the sample after placing it on the support. Freeze-drying proteins is well known in the art for the purpose of storing precipitated or denatured proteins for future sample analysis (Furuoya Examples 1-9, 3rd paragraph). Therefore, it would have been obvious to one of ordinary skill in the art to add to the Stillman method a freeze-drying step for the ability to store the protein sample.

Art Unit: 1743

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stillman in view of McCaffery (USP 4,629,785). Stillman does not disclose dissolved salts of either picric acid, gallotannic acid, tungstic acid, molybdenum acid, trichloroacetic acid, perchloric acid, or suphosalicic acid. However, Stillman discloses using a salt solution and the claimed acids are obvious functional equivalents of those that Stillman disclosed. Perchloric, trichloroacetic and tungstic acid, for example, are well known in the art to precipitate proteins, forming salt solutions (McCaffery Column 2 lines 60-65). Therefore, it would have been obvious to one of ordinary skill in the art to modify the Stillman method's salt solution with functional equivalents such as picric acid, gallotannic acid, tungstic acid, molybdenum acid, trichloroacetic acid, perchloric acid, or suphosalicic acid.

Response to Arguments

11. Applicant has not overcome the rejection under 35 USC 102(e) in accordance with MPEP § 706.02(b) since Applicant has not provided an English language translation of the certified priority document filed January 22, 2002, the date necessary to overcome the rejection. A note by the Applicant that the PCT/03/00357 is identical in wording to the priority document EP 02001519.4 does not meet the requirements of MPEP § 706.02(b) (see below). Attorney arguments do not replace a certification that the specification of the PCT and EP priority document are identical. See MPEP § 716.01(c). Without an English translation of the EP priority document, the Examiner

Art Unit: 1743

cannot determine whether the priority document satisfies the enablement and description requirements of 35 USC 112, first paragraph.

The relevant wording from MPEP § 706.02(b) is pasted below.

"A rejection based on 35 U.S.C. 102(e) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

....

(E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d) within the time period set in 37 CFR 1.55(a)(1) or filing a grantable petition under 37 CFR 1.55(c). See MPEP § 201.13. The foreign priority filing date must antedate the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application (and an English language translation, if the document is not in English) (see 37 CFR 1.55(a)(3)) and the examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. 112, first paragraph,"

MPEP § 706.02(b).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schubert (USP 6,150,173) and Danssaert (USP 5,525,300) disclose methods of sample preparation.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1743

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keri A. Moss whose telephone number is 571-272-8267. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keri A. Moss
Examiner
Art Unit 1743

KAM 11/15/06


ARLEN SODERQUIST
PRIMARY EXAMINER